

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUMASA ONO
and KENJI KOMATSU

Appeal No. 2003-0190
Application No. 08/515,964

HEARD: May 13, 2003¹

Before RUGGIERO, DIXON, and SAADAT, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-11, which are all of the claims pending in the application.

The claimed invention relates to a timing arrangement for an internal combustion engine in which a timing sensor cooperates with the engine camshaft to provide a signal indicative of the

¹ We note that our prior decision in this prosecution Appeal 1999-0829, mailed July 18, 2001, record the examiner's rejection.

camshaft position and the engine output shaft. The timing sensor is mounted on the bearing cap of the camshaft with the timing sensor and bearing cap extending through an opening in a cam cover, thereby permitting access to the timing sensor without removing the cam cover.

Claim 1 is illustrative of the invention and reads as follows:

1. A timing arrangement for an internal combustion engine having an engine component in which a camshaft is rotatably journaled, said camshaft being journaled at least in part by a bearing cap affixed to said engine component, and a timing sensor carried by said bearing cap and cooperating with said camshaft for providing a signal indicative of the timing relationship of said engine.

The Examiner relies on the following references:

Klauber et al. (Klauber)	5,287,735	Feb. 22, 1994
Takano	6,148,787	Nov. 21, 2000
		(Filed May 11, 1999)

Claims 1-11, all of the appealed claims, stand finally rejected under 35 U.S.C. § 102(f) and 35 U.S.C. § 102(g). Claims 1-11 stand further finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-9 of U.S. Patent No. 6,148,787 (Takano). In addition, independent claim 1 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Klauber.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer. We will reverse all of the Examiner's rejections before us on appeal.

We consider first the Examiner's rejection of claims 1-11 under 35 U.S.C. § 102(f) based on the asserted reasoning that Appellants did not invent the claimed subject matter. According to 35 U.S.C. § 102(f), a person shall be entitled to a patent unless he did not invent the subject matter sought to be patented. The Examiner relies (Answer, page 5) upon various

² The Appeal Brief was filed May 6, 2002 (Paper No. 25). In response to the Examiner's Answer dated July 22, 2002 (Paper No. 26), a Reply Brief was filed August 2, 2002 (Paper No. 27), which was acknowledged and entered by the Examiner as indicated in the communication dated August 27, 2002 (Paper No. 29).

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passages at columns 3, 4, and 5 as well as claims 6, 8, and 9 of the patent to Takano in concluding that Appellants Ono and Komatsu did not invent the subject matter now sought to be patented. It is noteworthy that the record reveals that both the patentee and the Appellants are assignors to Yamaha Hatsudoki Kabushiki Kaisha. The issued patent to Takano must include, of course, an oath, consonant with 35 U.S.C. § 115, as to the belief that they are the original and first inventors of the subject matter for which a patent is solicited, i.e., their claimed invention. Similarly, the oath of Appellants Ono and Komatsu in the instant application comports with 35 U.S.C. § 115 as to their claimed subject matter directed to a timing arrangement for an internal combustion engine, which as pointed out by Appellants (Brief, page 4) differs from the accessory drive mounting structure claimed by Takano. In the current circumstance, strong evidence is required to reach the contrary conclusion that Ono and Komatsu are not the inventors of their claimed invention. See Ex parte Kusko, 215 USPQ 972, 974 (Bd. App. 1981).

As MPEP Section 706.02(g) points out, an Examiner should presume proper inventorship unless there is proof that another or others made the invention and that an inventor(s) derived the invention from the true inventor(s). In the present case, and

contrary to the view of the Examiner, it is quite apparent to us that the showing in the referenced sections of the Takano patent, in and of itself, fails to provide the requisite proof that the claimed invention was in fact made by patentee Takano, and that Appellants Ono and Komatsu derived the invention from Takano. Lacking the noted proof, the rejection under 35 U.S.C. § 102(f) is not sound and cannot be sustained.

We also do not sustain the Examiner's rejection of claims 1-11 under 35 U.S.C. § 102(g) which states that a person is entitled to a patent unless before the applicant's invention thereof the invention was made ... by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. While more commonly applied to interferences, section 102(g) is applicable to prior invention situations other than in the context of an interference. See New Idea Farm Equipment Corp. v. Sperry Corp., 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990).

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It is clear, however, that, in order to support a rejection under 35 U.S.C. § 102(g), evidence must be provided that the claimed subject matter was actually reduced to practice by another before an applicants' invention. We find the record before us to be totally devoid of any such evidence. Clearly, the Takano reference relied on by the Examiner, which has a filing date nearly four years later than the filing date of Appellants' application, provides no evidence of the required reduction to practice, let alone conception, to support a rejection under 35 U.S.C. § 102(g).

We next consider the Examiner's rejection of appealed claims 1-11 based on the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-9 of U.S. Patent No. 6,148,787 (Takano). While we do not disagree with the Examiner that the rejected claims in the present application are arguably obvious variations of the claims 1, 6, 8, and 9 of the Takano patent, it is our opinion that, under the factual situation in the case before us, the Examiner must also show, and which the Examiner has not done, that Takano's patent claims are obvious variations over the rejected claims in the application (i.e., two-way obviousness test). See In re Braat, 937 F.2d 589, 593, 19 USPQ2d 1289, 1293 (Fed. Cir. 1991). The

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Takano application which matured into a patent was filed nearly four years after the filing of Appellants' application.

Appellants could not have included the Takano patent claims, directed to an engine accessory drive mounting arrangement, in their application since they did not invent such subject matter. Further, it is apparent from the record before us that Appellants are not responsible for the fact that the Takano claims, which included Appellants' claimed bearing cap carried timing sensor feature in the larger combination of an engine accessory mounting structure, issued before their application. Accordingly, the Examiner's rejection of claims 1-11 on the basis of obvious double patenting is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claim 1 based on Klauber, we do not sustain this rejection as well. After careful review of the applied Klauber reference, in light of the arguments of record, we are in general agreement with Appellants that the Examiner has failed to establish a prima facie case of obviousness since Klauber does not teach or suggest all of the limitations of independent claim 1. In particular, we are in agreement with Appellants (Brief, page 5) that, in contrast to the claimed timing sensor, the sensor 24 in Klauber which is carried by a bearing cap is a shaft

torsional stress/strain sensor. Although the Examiner has pointed to a passage (column 8, line 59) in Klauber which suggests that the sensor 24 could be a function of shaft speed, we find no support for the Examiner's conclusion that this results in a signal which is indicative of the timing relationship of an engine as claimed. To the contrary, the illustrated output of sensor 24 in Klauber is the torque curve in Figure 13 which merely illustrate the torque peaks which occur during a given cylinder power stroke.

In view of the above discussion, it is our view that, since all of the limitations of the appealed claim 1 are not taught or suggested by the applied prior art reference, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C. § 103(a) rejection of independent claim 1 is not sustained.

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In conclusion, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-11 is reversed.

REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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